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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,607	01/14/2002	Andrew C. Gilbert	01-1034 CF734	5741
63710 7590 12/19/2008 DEAN P. ALDERUCCI CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER TINKLER, MURIEL S				
ART UNIT 3691		PAPER NUMBER		
MAIL DATE 12/19/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/047,607

Applicant(s)

GILBERT ET AL.

Examiner

MURIEL TINKLER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 12-5-2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application has been reviewed. Claims 1-41 are pending. The rejection(s) are as follows.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2008 has been entered.

Response to Arguments

2. Applicant's arguments, see the Interview Summary, filed September 30, 2008, with respect to the rejection(s) of claim(s) 1-41 under Double Patenting, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 USC 112, 1st paragraph, 35 USC 101, Silverman (US 6,625,583 B1) and Silverman (US 5,136,501 A).

Response to Amendment

3. The amendment filed November 9, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35

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U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: computer data signals conveying two passive orders to be mediated with assistance of the computer system (there is no indication in the database of two passive orders being used or that these two orders are mediated with assistance of the computer system) ; a database indicating that a first/second of the two passive orders is entered (the specification indicates that the database is designed to indicate which participants utilize a principal/broker relationship and what limitations are placed on the activity, see pages 3-4); and, electronically determining the presentation of the first/second passive order (there is no mention in the specification of the determining the presentation of a first/second order). Based on the discussions above claims 6 and 14 will be rejected due to lack of support in the specification.

4. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 2, 6, 9, 10, 14, 15 and 17-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not patent eligible subject matter because the claimed

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invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). In this case, independent claims 1, 6, 9 and 14: require no physical transformation and the invention as claimed does not produce a useful concrete and tangible result because the limitations in the claims are comprised of non-functional descriptive material; the limitations in these claims simply take information from one source and transports it to be displayed. Dependent claims 2, 10, 15 and 17-32 do not cure this deficiency and are therefore also rejected.

7. Claims 1-13, 16 and 24-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not patent eligible subject matter because the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). In this case, independent claims 1, 6, 8, 9, 11 and 16 have no corresponding hardware used in the body of the claims. Therefore, these claims can be considered software or an abstract idea. Dependent claims 2-5, 10, 12, 13 and 24-41 do not cure this deficiency and are therefore also rejected.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 6, 7, 14, 15 and 17-41 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The added material which is not supported by the original disclosure is as follows: computer data signals conveying two passive orders to be mediated with assistance of the computer system; a database indicating that a first/second of the two passive orders is entered; and, electronically determining the presentation of the first/second passive order which are critical or essential to the practice of the invention, is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The above elements are considered new matter because they are elements represented in the independent claims 6 and 14 and are not supported in the specification. Dependent claims 7, 17 and 17-41 do not cure this deficiency and are therefore also rejected.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an

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international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al. (US 6,625,583 B1) hereafter referred to as Silverman '583.

13. Claims 1 and 9 discuss a system and method for presenting a trading interface, comprising: receiving a first passive trading command from a broker workstation; receiving a second passive trading command from a principal workstation; displaying the first passive trading command and the second passive trading command using a special designation, which indicates bid availability on a trader workstation. Silverman '583 discloses the information in Claims 1 and 9. Specifically Silverman '583 discloses: the use of a broker in column 1 (lines 20-26); the use of a principle workstation or trading booth in column 1 (lines 27-40); sending and receiving passive trading commands in figure 1; displaying passive trading commands using use tabs in column 4 (lines 11-42).

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14. Claims 2 and 10 discuss the system and method of claims 1 and 9, wherein the displaying of the first trading command and the second trading command comprises displaying the first passive trading command in a different manner from the second passive trading command wherein the different manner is using different colors, using different fonts, using flashing or hiding an unavailable passive trading command. Silverman '583 discloses the information in Claims 1, 2, 9 and 10. See the rejection(s) of Claims 1 and 9 above. Specifically Silverman '583 discloses displaying the first and second passive commands in a different manner in the Summary of the Invention in column 2 (lines 25-53).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3-5, 8, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman '583 and Silverman et al. (US 5,136,501 A) hereafter referred to as Silverman '501.

17. Claims 3-5, 8 and 11-13 discuss a system and method for trading, comprising: trader; receiving a trading command from a first determining whether the first trader is acting as a broker; trader; and presenting the trading command

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to a second preventing the second trader from acting on the trading command when the first trader is acting as a broker so that the trading command does not form part of the trade and blocking the completion of the transaction. Silverman '583 discloses the information in Claims 3-5, 8 and 11-13. See the rejection(s) of Claims 1 and 9 above. Silverman '583 does not disclose the act of preventing a trader from acting on a trade. Silverman '501 teaches the art of preventing a trader from acting on a trade in the Abstract, column 3 (lines 18-38), column 4 (line 27) through column 5 (line 35) and column 17 (line 59) through column 18 (line 9). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Silverman '583 to gain the ability to block trade because, according to Silverman '501 in Disclosure of the Invention, to controllably mask the available trading market and efficiently transmit only the required matching information to those key stations which require it.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691